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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT: Wyatt

EXAMINER: N. Pass

SERIAL NO.: 09/544,509

GROUP ART UNIT: 3626

FILING DATE: April 6, 2000

ATTY. DOCKET NO.:MCO-P-00-003

INVENTION: "A METHOD AND SYSTEM FOR MATCHING MEDICAL CONDITION INFORMATION WITH A MEDICAL RESOURCE ON A COMPUTER NETWORK"

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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APPELLANT'S REPLY BRIEF

MADAM:

Appellant submits herewith, in triplicate, Appellant's Reply Brief in response to the Examiner's Answer dated January 15, 2004.

Appellant submits that no fee is required for submission of this Reply Brief. However, the Patent Office is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to Deposit Acct. No. 50-0595. A duplicate of this sheet is enclosed for this purpose.

Respectfully submitted,


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APPELLANT'S REPLY BRIEF

MADAM:

This Reply Brief is submitted in response to the Examiner's Answer dated January 15, 2004. In the Examiner's Answer, the arguments presented in the Appeal Brief filed October 27, 2003 were not found persuasive by the Examiner. Additionally, the Examiner raised three new points of argument in the Examiner's Answer.

I. THE REFERENCES "TAKEN SINGLY OR IN COMBINATION, DO NOT TEACH OR SUGGEST CLAIMS 1-11 and 13-20, AND IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE THEM BY ONE HAVING ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION"

In the Examiner's Answer, the Examiner asserts:

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However, it has been

held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references.

Additionally, the Examiner asserts:

the Examiner is concerned that, aside from merely alleging that certain claimed features are not taught or suggested by the applied references either alone or in combination, Appellant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Appellant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizer v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Contrary to the assertions of the Examiner, Claim 1 requires a method for matching medical condition information with a medical resource having a step of inputting a query into the website wherein the query relates to a medical condition. Moreover, Claim 1 requires a step of searching the database for

the information wherein the search is based on the query input into the database and the search discloses a medical resource that treats the medical condition queried.

Claim 15 requires a system for matching medical condition information with a medical resource having a means for querying the database wherein the query relates to one of the medical conditions. Moreover, Claim 15 requires a means for searching the database for the information wherein the information discloses a medical resource that treats the medical condition queried.

With respect to Claims 1 and 15, the Examiner states:

Iliff includes "[I]t is presently possible for a computer to search the world's medical literature daily. Any articles pertaining to a particular topic can automatically be requested and the information used to update the system. In addition, the MDATA system 100 is currently using optical character recognition technology to digitize its medical database. Then, using indexing techniques, the MDATA system 100 is able to search for and retrieve any information desired. For example, the system can search for the character string "headache" and retrieve any amount of surrounding text or graphic information. This information is then collected, collated, printed and referred to the physician(s) maintaining the headache algorithm."

Schlueter, Jr. et al. teaches "[r]equests for data by medical practitioners is transmitted to the primary computer in a manner similar to the transmission of raw data. In response to a request for data, output, in the form of a chart or graph, or multiple charts and graphs, is transmitted to the remote computer for display on the computer screen and/or printed for hard copy, or faxed to the medical practitioner or

assistant." *Schlueter, Jr. et al.* also teaches "[t]he primary computer 100 is a multi-purpose computer having software and hardware that enable it to receive information from the variety of sources mentioned, a microprocessor to process the data, store the data on a mass storage device integrated with the computer 100, and present the raw and processed data when required via output means. Its primary purpose is to receive medical readings over long periods of time, store the information as medical histories in a data base application, and present the information to medical practitioners in a form which facilitates accurate diagnosis and treatment of patients' chronic medical conditions and "the remote computer, using software commonly referred to as a "web browser," such as Netscape, Mosaic, or Internet Explorer, can access the primary computer 100, which would be set up as a "web server." Remote computer 50 is provided with software enabling automatic access, retrieval, and display of the required information at the request of the user-typically the medical practitioner or assistant."

Contrary to the assertions of the Examiner, *Iliff* merely teaches a system for providing computerized medical diagnostic advice to the general public over a network which determines if a serious medical condition exists and advises the patient to seek immediate medical attention if a serious medical condition exists. *Schlueter, Jr. et al.* merely teach a method and system that assists medical practitioners who treat or prescribe treatment of patients having a medical condition which requires long-term profiling of medical data taken from the patient's body.

In the Examiner's Answer, the Examiner further asserts that

the access and retrieval of information from the database on request, as recited by *Iliff*, reads on searching the database for the information and/or on means for searching for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried. Still further, the Examiner asserts that the access, retrieval and display of the required medical information remotely by using a web browser and accessing a web server which provides or serves the website and stores the database of medical information, as taught by *Schlueter, Jr. et al.*, reads on inputting a query into the website and/or on means for querying the database wherein the query relates to one of the medical conditions.

The Examiner admits that *Iliff* fails to explicitly disclose inputting a query into the website wherein the query relates to a medical condition. The Examiner alleges that *Schlueter, Jr. et al.* teach inputting a query or request for data into the website wherein the query relates to a medical condition. On the contrary, *Schlueter, Jr. et al.* merely teach a "method and system which receives medical readings over long periods of time, stores the information as medical histories in a data base application, and presents the information to medical practitioners in a form which facilitates accurate diagnosis and

treatment of patients' chronic medical condition." (See *Schlueter, Jr. et al.*, column 5, lines 47-52.) Nowhere does *Schlueter, Jr. et al.* teach or suggest inputting a query into the website wherein the query relates to a medical condition as alleged by the Examiner.

Clearly, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method for matching medical condition information with a medical resource having a step of inputting a query into the website wherein the query relates to a medical condition as required by Claim 1. Neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a method for matching medical condition information with a medical resource having a step of searching the database for the information wherein the search is based on the query input into the database, and the search discloses a medical resource that treats the medical condition queried as required by Claim 1.

Appellant submits that the method defined by Claim 1 requires the steps of inputting a query into the website wherein the query relates to a medical condition and searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition

queried. Further, Appellant submits that the method of the claimed invention clearly requires defined steps in the claims that distinguishes the claimed invention from *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination. Moreover, the art fails to teach or suggest the specific steps defined in Claim 1; therefore, Claim 1 is patentably distinct from *Iliff* and/or *Schlueter, Jr. et al.*, taken singly or in combination.

With respect to Claim 15, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having means for querying the database wherein the query relates to one of the medical conditions as required by Claim 15. Further, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having means for searching the database for the information wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 15. Nowhere does *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system having a means for searching for the information based on a query wherein the information discloses a medical resource that treats the medical

condition queried. Thus, neither *Iliff* nor *Schlueter, Jr. et al.*, taken singly or in combination, teach or suggest a system for matching medical condition information with a medical resource having means for searching the database for the information wherein the search is based on the query of the database and further wherein the information discloses a medical resource that treats the medical condition queried as required by Claim 15.

Appellant submits that the system of the claimed invention clearly requires defined elements in Claim 15 that distinguishes the claimed invention from *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination. Moreover, the art fails to teach or suggest the specific elements defined in the Claim 15. Therefore, Claim 15 is patentably distinct from *Iliff* and/or *Schlueter, Jr. et al.*, taken singly or in combination.

Appellant further submits that one having ordinary skill in the art at the time of Appellant's invention would never have been motivated to modify *Iliff* with *Schlueter, Jr. et al.* in the manner suggested by the Examiner in formulating the rejections under 35 U.S.C. §103(a).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements

perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

With the analysis of the deficiencies of *Iliff* and *Schlueter, Jr. et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Appellant's invention would have been motivated to combine *Iliff* with *Schlueter, Jr. et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Therefore, *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

Even assuming that one having ordinary skill in the art could somehow have combined *Iliff* and *Schlueter, Jr. et al.* as set forth by the Examiner, the resultant combination still lacks the critical steps and elements positively recited in Claims 1 and 15, respectively.

Contrary to the assertions of the Examiner, Appellant submits that Appellant is relying on features expressly recited in Claims 1 and 15; that the features expressly recited in Claims 1 and 15 are within none of the teachings of *Iliff* and/or *Schlueter, Jr. et al.*, taken singly or in combination; and that Appellant has properly considered the teachings of *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination.

Appellant further submits that the access and retrieval of information from the database on request, as recited by *Iliff*, fails to read on the features expressly recited in Claims 1 and 15. Moreover, Appellant submits that the access, retrieval and display of the required medical information remotely by using a web browser and accessing a web server which provides or serves the website and stores the database of medical information, as taught by *Schlueter, Jr. et al.*, fails to read on the features expressly recited in Claims 1 and 15.

In view of the foregoing, Appellant submits that the rejection of Claims 1 and 15 under 35 U.S.C. §103(a) is

improper.

II. THE REFERENCES "TAKEN SINGLY OR IN COMBINATION, DO NOT TEACH OR SUGGEST CLAIM 12, AND IT WOULD NOT HAVE BEEN OBVIOUS TO COMBINE THEM BY ONE HAVING ORDINARY SKILL IN THE ART AT THE TIME OF THE INVENTION"

In the Examiner's Answer, the Examiner asserts:

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However, it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references.

In particular, Examiner notes *Iliff, Schlueter, Jr. et al.* and *Siegrist, Jr. et al.* specifically teach the steps of "disclosing a plurality of medical resources that treat the disorder queried" and "ranking or comparing the medical resources based on how the medical resources match the query" recited in Claim 12.

Contrary to the assertions of the Examiner, dependent Claim 12 does not require a step of comparing the medical resources based on how the medical resources match the query. Claim 12 defines a method for matching medical condition information with a medical resource having the step of disclosing a plurality of medical resources that treat the disorder queried.

Additionally, Claim 12 requires the step of ranking the medical resources based on how the medical resources match the query.

Further, the Examiner states:

that Siegrist, Jr. et al. teaches "[t]he information used to compare a service provider to its competitors is determined according to parameters generated by the user. Prior comparison, data representing the performance of the competitors is adjusted to reflect the clientele of the service provider. This adjustment does not affect the service provider's data. The invention is also able to provide multiple levels of comparison, depending upon the level of detail required by the user" (Siegrist, Jr. et al., column 2, lines 41-54). Siegrist, Jr. et al. also includes "a hospital comparison report is requested. To request a report, a user must enter 104 report request parameters 18 which are used by the computer system 5 to retrieve and manipulate the cost and charge information stored in the database 12. The parameters 18 input by the user determine, for example, which patient groups to compare in which hospitals and, therefore, which of the patient level cost and charge information 12d to retrieve from the database 12. Once the appropriate information has been retrieved, the information is accumulated to create total cost and charge information 20 for the chosen patient groups in the chosen hospitals. Even though the maintenance of cost and charge information for every patient of every hospital in a city (or even the nation) requires an enormous database, retrieval and combination of data according to user-defined parameters eliminates unnecessary manipulation of data irrelevant to the particular report being generated" (Siegrist, Jr. et al.; column 2, lines 41-54, column 3, line 65 to column 4, line 16). The comparison of medical service providers/hospitals according to parameters (e.g. area of specialty, costs, clientele, etc.) determined by users, as recited by Siegrist, Jr. et al., fails to read disclosing a plurality of medical resources that treat the disorder queried; and ranking or comparing the medical resources based on how the medical resources match the query

Contrary to the assertions of the Examiner, *Siegrist, Jr.* et al. merely teach a computer-based method which relates to analysis and reporting of performance of service providers. Additionally, *Siegrist, Jr. et al.* teach that "the data may include data (e.g., financial data) concerning the competitive performance of a medical service business." Further, *Siegrist, Jr. et al.* teach that "this information is used to generate a report which focuses the attention of the service provider on the most promising opportunities for cost savings, profit improvements, and improved competition." Moreover, *Siegrist, Jr. et al.* teach that "the report helps hospitals plan strategies for cutting costs and improving their competitive position."

None of *Iliff, Schlueter, Jr. et al.*, or *Siegrist, Jr. et al.*, taken singly or in combination, teach the elements of independent Claim 1, from which Claim 12 depends. More specifically, none of the references teach a method having the steps of inputting a query into the website wherein the query relates to a medical condition and searching the database for the information wherein the search is based on the query input into the database and further wherein the search discloses a medical resource that treats the medical condition queried as

required by Claim 1.

It is submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. *In re Simon*, 461 F. 2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most, if not all, elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of all the teachings of the references in their entireties, would have been obvious to one of ordinary skill in the art at the time the invention was made. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1545, 220 USPQ 193 (Fed. Cir. 1983).

Appellant submits that the Examiner has merely located components of Appellant's claimed invention. However, that the art disclosed components of Appellant's claimed invention, either separately or used in other combinations, is insufficient. A teaching, suggestion, or incentive must exist to make the combination made by Appellant. *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988). No such teaching, suggestion or incentive exists in *Iliff, Schlueter, Jr. et al.* or *Siegrist, Jr. et al.*,

to provide the features set forth in Appellant's invention. Therefore, one of ordinary skill in the art would not have been motivated at the time of Appellant's invention to combine *Iliff, Schlueter, Jr. et al.* and *Siegrist, Jr. et al.*

Still further, Appellant submits that the Examiner is merely "piece-mealing" references together providing various teachings and positively defined steps of Appellant's method to deprecate the claimed invention. Of course, hindsight reconstruction of Appellant's invention is impermissible. Since no suggestion exists to combine *Iliff, Schlueter, Jr. et al.* and *Siegrist, Jr. et al.*, the Examiner cannot arbitrarily do so to reject the claims. Instead, a reason is required why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975).

The court in *In re McLaughlin* stated "[T]here is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art." *In re McLaughlin*, 170 USPQ 209 (CCPA 1971).

In considering obviousness, the critical inquiry is whether something in the art as a whole suggests the desirability, and

thus the obviousness, of making a combination. *In re Newell*, 891 F.2d 899, 901-02, 13 USPQ 2d 1248, 1250 (Fed. Cir. 1987).

Since the Examiner has failed to establish a *prima facie* case of obviousness in combining *Iliff* and *Schlueter, Jr. et al.* with *Siegrist, Jr. et al.*, the rejection of Claim 12 under 35 U.S.C. §103(a) is improper.

Contrary to the assertions of the Examiner, Appellant submits that Appellant is relying on features expressly recited in Claim 12; that the features expressly recited in Claim 12 are within none of the teachings of *Iliff*, *Schlueter, Jr. et al.* or *Siegrist, Jr. et al.*, taken singly or in combination; that Appellant has properly considered the teachings of *Iliff*, *Schlueter, Jr. et al.* and *Siegrist, Jr. et al.*, taken singly or in combination; that the comparison of medical service providers/hospitals according to parameters determined by users, as recited by *Siegrist, Jr. et al.*, fails to read on the features expressly recited on Claims 1 and 12.

In view of the foregoing, Appellant submits that the rejection of Claim 12 under 35 U.S.C. §103(a) is improper.

III. THE TOTALITY OF THE REFERENCES IN THEIR ENTIRETIES DOES NOT COLLECTIVELY SUGGEST THE CLAIMED INVENTION TO ONE OF ORDINARY SKILL IN THE ART AND THERE IS NO TEACHING, SUGGESTION, OR INCENTIVE IN THE ART TO MAKE OBVIOUS THE COMBINATION OF THE APPLIED REFERENCES

In the Examiner's Answer, the Examiner alleges:

that Appellant appears to view the applied references separately and in a vacuum, without considering the knowledge of average skill in the art, and further fails to appreciate the breadth of the claim language that is presently recited.

Moreover, Appellant apparently ignores the evidence given by the Examiner, namely recitations of specific portions of the applied references, express articulation of the combinations and the motivations for combinations, as well as the scientific and logical reasoning of one skilled in the art at the time of the invention, as given in the prior Office Actions and reiterated in the present Examiner's Answer.

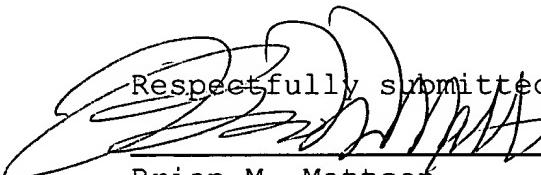
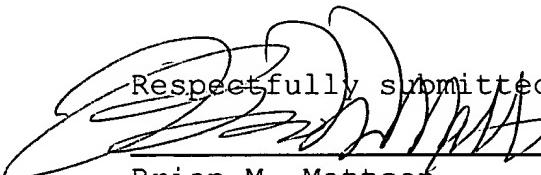
Appellant's arguments seem to indicate that Appellant's invention is merely a combination of old and well-known elements. As specified in the remarks and rebuttals given above, Appellant's arguments apparently fail to appreciate the clear and unmistakable suggestions provided in the prior art of record, and relied upon by the Examiner for motivation to combine such well-known elements of the prior art.

Contrary to the assertions of the Examiner, Appellant submits that with the analysis of the deficiencies of *Iliff* and *Schlueter, Jr. et al.* in mind, as enumerated above, no reason or suggestion in the evidence of record exists why one of ordinary skill in the art at the time of Appellant's invention would have been motivated to combine *Iliff* with *Schlueter, Jr. et al.* in the manner suggested by the Patent Office in formulating the rejection under 35 U.S.C. §103(a). Further, Appellant submits that *prima facie* obviousness has not been established by the Patent Office as required under 35 U.S.C. §103(a).

Appellant further submits that Appellant considered the

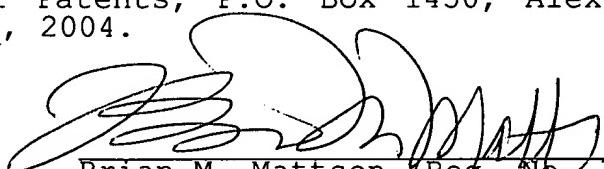
knowledge of one having ordinary skill in the art at the time of Appellant's invention and appreciates the breadth of the claim language that is presently recited; that Appellant's invention is not merely a combination of old and well-known elements; that the *prima facie* case of obviousness has not been satisfied by the teachings of *Iliff* or *Schlueter, Jr. et al.*, taken singly or in combination; and that *Iliff* and *Schlueter, Jr. et al.*, taken singly or in combination, fail to present the combinations and/or the motivations for combinations that suggest Appellant's claimed invention.

In view of the foregoing remarks, Appellant respectfully submits that all of the claims in the application are in allowable form and requests the Board to reverse the rejections of the Examiner.


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CERTIFICATE OF MAILING

I hereby certify that this **REPLY BRIEF** is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 01, 2004.


Brian M. Mattson (Reg. No. 35,018)